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United States Application No.: 10/590,461
Response to Office Action mailed August 4, 2009

BEFORE THE UNITED STATES PATENTS OFFICE

Inventors: John MacDougall
Title: JACKETED ONE PIECE CORE AMMUNITION
Serial No.: 10/590,461
Filed: August 23, 2006
Our File: 5008-134-14
Confirm No.: 9756
Art Unit: 3641

September 4, 2009

Mail Stop Amendment
The Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450 U.S.A.

Dear Sir:

Response after Office Action

This letter is in response to the Examiner's Office Action of August 4, 2009 for which a
Response is due by September 4, 2009.

Amendments

In the Claims

Please amend the Claims as shown in Schedule "A", attached hereto.

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Amendments to the Claims

The applicant elects, respectfully with traverse, claims 1-19. Applicant withdraws Claims 20-23. In addition Applicant amends claims 1-3.

DISCUSSION

Amendments to claims 1 – 3

Claims 1 and 2 have been amended to recite a tapered separation between the jacket and the core along at least a portion of the length of the midsection portion of the central core. This limitation was originally present in claim 3.

Support for the amendment to claims 1 and 2 is found at paragraph [0082]: *"However, by reason of the frusto-conical shape of the intervening middle portion 14 and the fact that the jacket 11 is generally cylindrical in shape, particularly on its inside surface, there is a small separation or gap 15 between the projectile jacket 11 and the frusto-conical portion 14 of the core 12."*

Claim 3 has been amended to indicate the lack of support of the jacket in the midsection portion along at least a portion of the length of the midsection portion, over the length of the separation. Support for the amendment to claim 3 is found at paragraph [0062]: *The jacket in this region is "unsupported" by the core in the sense that little resistance to engraving forces applied to the jacket in this region is provided by material underlying the jacket. This absence of support arises within a portion of the midsection of the core.*

No new subject matter has been introduced by way of these amendments.

Examiner's objections

Restriction under PCT Rule 13.1

The Examiner has requested an election requirement, claiming a lack of unity of invention based on PCT Rules 13.1 and 13.2. In particular, the Examiner alleges that claims 1-19 are directed to species 'A' as illustrated in Figs. 4 and 6, while claims 20-23 are directed to species 'B' as illustrated in Fig. 5. Claims 1-19 are directed towards a jacketed projectile, while claims 20-23

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are directed towards a cartridge that comprises the projectile and a casing. The Examiner further states that species 'A' does not contain the casing as claimed for species 'B'.

With due respect, the applicant believes the Examiner is incorrect in interpreting PCT Rules 13.1 and 13.2.

Rule 13.1 PCT states that the international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.

Rule 13.2 PCT further specifies this by stating that Rule 13.1 is fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding technical features. The expression "special technical feature" meaning those features that define a contribution which each of the claimed inventions makes over the prior art.

Applicant submits that the special technical feature of the present invention, as defined by PCT Rule 13.2, is the jacketed projectile, and not the casing. This special technical feature; i.e., the jacketed projectile, is common to both claims 1 and 20. Furthermore, it is this special technical feature that defines a contribution which both claims 1 and 20 make over the prior art.

Applicant refers to Section 10.03 of Chapter 10 ("Unity of Invention") of the PCT International Search and Preliminary Examination Guidelines (as in force from March 25, 2004), which states:

"10.03 Lack of unity of invention may be directly evident "*a priori*", that is, before considering the claims in relation to any prior art, or may only become apparent "*a posteriori*", that is, after taking the prior art into consideration. For example, independent claims to A+X, A+Y, X+Y can be said to lack unity *a priori* as there is no subject matter common to all claims. In the case of independent claims to A+X and A+Y, unity of invention is present *a priori* as 'A' is common to both claims. However, if it can be established that 'A' is known, there is a lack of unity *a posteriori*, since 'A' (be it a single feature or a group of features) is not a technical feature that defines a contribution over the prior art."

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Applicant submits that unity of invention exists between independent claims 1 and 20 *a priori*, as the technical feature common to both is the jacketed projectile.

In addition, Applicant refers to Section 10.34, Example 14 (p. 83 of the PCT ISPE Guidelines):

"10.34 Example 14:

Claim 1: A marking device for marking animals, comprising a disc-shaped element with a stem extending normally therefrom, the tip of which is designed to be driven through the skin of the animal to be marked, and a securing disk element to be fastened to the protruding tip of the stem on the other side of skin.

Claim 2: An apparatus for applying the marking device of claim 1, constructed as a pneumatically actuated gun for driving the step of the disc-shaped element through the skin, and provided with a supporting surface adapted for taking up a securing disc element, to be placed at the other side of the body portion in question of the animal to be marked.

The special technical feature in claim 1 is the marking device having a disc-shaped element with a stem and a securing disc element to be fastened to the tip of the stem. The corresponding special technical feature in claim 2 is the pneumatically actuated gun for driving the marking device and having a supporting surface for the securing disc element. Unity exists between claims 1 and 2."

Applicant submits that Example 10.34 is analogous to the present situation. The common technical feature to both claims 1 and 20 is the jacketed projectile.

Applicant respectfully requests Examiner to withdraw the Unity of Invention objection, as it has been shown above, that unity of invention exists *a priori* between claims 1 and 20 of the present application.